



CASE SF0820K2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**-----X  
In re Application of: :**Duvert-Frances et al.** :

Examiner: Ewoldt, G. :

For Patent For: :

Group Art Unit: 1644 :

**ANTIBODIES TO MAMMALIAN  
LANGERHANS CELL ANTIGEN  
AND THEIR USES** :

Date: October 22, 2002 :

Serial No.: 09/787,192 :

Filed: March 15, 2001 :  
-----XAssistant Commissioner for Patents  
Washington, D.C. 20231**RECEIVED**  
OCT 30 2002  
TECH CENTER 1600/2900**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

This communication is in response to the Restriction Requirement dated October 2, 2002, in the above-identified patent application. Claims 1-15 are pending in the application. The Examiner has restricted the claims into six groups: Invention 1 (antibodies and hybridomas, claims 1-4), Invention 2 (methods for analyzing cell populations, claim 5), Invention 3 (human proteins, claims 6, 7 and 9), Invention 4 (murine proteins, claims 6 and 11), Invention 5 (human nucleic acids, claims 10, 11, 14 and 15), and Invention 6 (murine nucleic acids, claims 12 and 13). In an October 17, 2002 phone call to the Examiner, the undersigned ascertained that claim 8, which was omitted from any of the groupings of the Restriction Requirement, should be included in the invention of Group IV.

Applicants traverse the Restriction to the extent it separates human and murine proteins and nucleic acids from each other. At most, Applicants believe that four groups are justified: antibodies, methods, mammalian proteins and mammalian nucleic acids.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Customer Service Center, Initial Patent Examination Division, Assistant Commissioner for Patents, Washington, D.C. 20231 on this 3rd day of July 2001.

October 22, 2002  
Date  
SignatureJaye McLaughlin  
Reg. No. 41,211

The Restriction Requirement is improper for failure to show a serious burden on the Examiner to examine the claims in a single application, and should be withdrawn.

The Examiner is respectfully reminded that MPEP § 803 states:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

The Examiner has not provided any reason or showing that a serious burden will result by examining the human and murine protein claims together, and the human and murine nucleic acid claims together. The inventions, which are together covered by a generic claim to “mammalian” polypeptides or nucleic acids, are clearly related. Due to the commonality of invention, a complete examination of claims 6, 7, 9 and 11 together and of claims 10-15 together would not cause undue burden. Furthermore, the same art search will most probably apply to the alleged separate inventions.

More importantly, by requiring Applicants to prosecute separate applications for the human and mouse embodiments of the invention, the Examiner is denying Applicants the opportunity to prosecute and defend broader claims to mammalian proteins and nucleic acids. A judgment as to whether such broad claims are supported by the specification is inappropriate at this time in the prosecution of the application, and is more appropriately presented in a substantive action on the merits.


Applicants therefore respectfully urge the Examiner to consider reducing the number of restriction categories, combining groups III and IV and groups V and VI. Applicants would greatly appreciate the examination of these claims together for the purpose of streamlining prosecution and reducing the burden on the Applicants.

In the event the Examiner is unable to accommodate the above request, Applicants hereby elect to prosecute the claims of Group V (claims 10, 11, 14 and 15). Applicants reserve the right to file divisional applications directed to the non-elected subject matter.

October 22, 2002

The Commissioner is authorized to charge any fees in order to enter this Response to Restriction Requirement to Deposit Account No. 19-0365.

Respectfully submitted,

  
Jaye P. McLaughlin  
Reg. No. 41,211

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.